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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,295	04/02/2001	Bahija Jallal	038602/1125	8862

7590 06/22/2004

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EXAMINER

HOLLERAN, ANNE L

ART UNIT PAPER NUMBER

1642

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/822,295	Applicant(s) JALLAL ET AL.	
	Examiner Anne Holleran	Art Unit 1642	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 15 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The amendment of claim 12 (in subsection "c") causes claim 25 to lack antecedent basis with respect to a polypeptide comprising at least 95% identity to the amino acid sequence set forth in amino acid residues 1-48. This would require a new rejection under 112, 2nd.

The rejections of claims 12, 27 and 29 under U.S.C. 102(a) as being anticipated by Q93095 is maintained, because Q93095 teaches a polypeptide that comprises amino acid 164-243 of SEQ ID NO: 2, which would anticipate claim 12 (specifically 12(c) and 12(d)), 27 and 29. Q93095's sequence comprising amino acid 164-243 is the same as a sequence that is at least 90% identical over any part of 49-807 of SEQ ID NO: 2. The rejection of claims 12, 27 and 29 under 35 U.S.C. 102(b) as anticipated by Matthews is maintained because Matthews teaches a polypeptide comprising 89-120 of SEQ ID NO: 2, which anticipates claim 12 (specifically 12(b), 12(c) and 12(d)), 27 and 29. The rejection of claim 12, 27, 29, 31, 33 and 34 under 35 U.S.C. 102(e) is maintained, because Cheng teaches a polypeptide that comprises 790-802 of SEQ ID NO: 2 and because Cheng teaches a polypeptide that is at least 90% identical to a sequence of 24-294 of SEQ ID NO: 2. Cheng also teaches polypeptides fused to a GST polypeptide and pharmaceutical compositions. Additionally, the proposed amendment introduces new matter into the specification because the proposed claims would be drawn to polypeptides comprising fragments of a PTP04 polypeptide that do not have enzymatic activity. Please refer to advisory action mailed 1/20/2004. Also, it is noted that the second proposed after-final amendment contains a change that is not underlined, but was underlined in the after-final amendment filed 10/10/2003 that was not entered.

Alana M. Harris
ALANA M. HARRIS, PH.D.
PRIMARY EXAMINER
6/17/2004